

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re application of:** Pellet and Sanchez-Martinez

**Patent No.** 6,126,944

**Issued:** October 3, 2000

**Application No.** 08/480,850

**Filed:** June 7, 1995

**Confirmation No.** 9684

**For:** BACULOVIRUS EXPRESSION VECTORS  
AND RECOMBINANT ANTIGENS FOR  
DETECTING TYPE-SPECIFIC  
ANTIBODIES TO HERPES SIMPLEX  
VIRUS

**Examiner:** Louise N. Leary

**Art Unit:** 1623

**Attorney Reference No.** 6395-87124-02

**FILED VIA EFS**

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COMMISSIONER FOR PATENTS

**DECLARATION OF VALENTIN D. FIKOVSKY**

1. I, Valentin D. Fikovsky, am a Senior Patent Advisor for the Assignee of the above-referenced U.S. Patent No. 6,126,944, which is assigned to The United States of America as Represented by the Secretary of the Department of Health and Human Services (hereinafter "the Government"). I am employed by the Government in the Technology Transfer Office (TTO) at the Centers for Disease Control and Prevention (CDC) in Atlanta, Georgia. I have been registered as a Patent Agent since 1982, and prior to beginning to work at CDC in 2008 I had been the licensing director of the University of Nevada at Reno (UNR) and the Desert Research Institute (DRI). Prior to that, I had been employed by the Regents of the University of California as a Director at the Research Administration and Office of Technology Transfer, Office of the President.

2. My employment with CDC began on April 14, 2008. As stated in my prior Declaration, on May 14, 2008, Ms. Shope emailed me to ask me to help locate a patent file related to US Patent No. 6,013,433 which is related to the U.S. Patent No. 6,126,944 that is the subject of the present Petition to Revive. Our file tracking system indicated that the patent file

for U.S. Patent No. 6,013,433 (CDC reference number E-021-91/1) was still at Needle & Rosenberg, which had been the CDC's outside counsel for the above-referenced patent prior to the expiration of Needle & Rosenberg's patent services contract. A copy of this email was provided with my previous Declaration.

On May 15, 2008, I responded to Ms. Shope's email, noting that we did not receive notices from Needle & Rosenberg that the maintenance fees were due for four patents, including U.S. Patent No. 6,126,944, which is in the same patent family as U.S. Patent No. 6,013,433. A copy of this email also was provided with my previous Declaration.

On May 15, 2008, U.S. Patent No. 6,126,944 was still pending. All maintenance fees for the CDC are paid through outside law firms. The CDC procedure is that each outside law firm sends monthly maintenance fee reminders to the CDC for which instructions and/or funding are required, and the CDC then provides payment instructions to the outside law firm. Thus, an outside law firm would not send a reminder for any maintenance fee if payment was already instructed or payment already made. Since we had not received a maintenance fee reminder from the CDC's outside counsel for U.S. Patent No. 6,126,944, and since Inteum indicated the patent was in good standing, this indicated that instructions and sufficient funds had been provided for the counsel to pay the required maintenance fee for this patent by the October 3<sup>rd</sup> deadline.

3. On December 4, 2008, I received an email from Francisco Candal, who is a Patent Advisor at the CDC, forwarding a Notice of Expiration ("Notice") for U.S. Patent No. 6,126,944.

4. I assumed that that Notice had been entered into our system. This is because I received the Notice from a CDC Patent Advisor and according to the policies at TTO any patent correspondence is entered into our system before being sent to a Patent Advisor. In more detail, the procedure at the CDC for tracking patent correspondence is that when correspondence arrives, it is first docketed by one of our administrative staff, Cynthia Sherwood and Veronica Brown. The procedure is that patent correspondence is sent to a Patent Advisor only after it is docketed in the electronic database.

5. All of the CDC's active matters, including licensed patents, are handled by our outside attorneys. Currently, there are 843 active matter on my docket, which are all managed by our current outside counsel, Klarquist Sparkman LLP (hereinafter "Klarquist Sparkman") and Gifford, Krass, Sprinkle, Anderson & Citowski, P.C. (hereinafter "Gifford Krass"). Patent Advisors at the CDC rely on the contract counsel to docket any action required on any patent correspondence, and to inform us of any deadlines. This would include filing a Petition to Revive if a patent was abandoned incorrectly, such as for the failure to pay a maintenance fee. When the Notice was received, I assumed that since U.S. Patent No. 6,126,944 was licensed, outside counsel would have the patent file, and would contact me to inform me of any relevant deadlines, and provide advice as to how to revive the patent. To the best of my knowledge, it was the understanding of all personnel in TTO in 2007 that all active files requiring action had been transferred from Needle & Rosenberg to one of CDC's current law firms, and that only inactive files were retained at the TTO offices at CDC.

6. As stated in my prior declaration, this matter did not come to my attention again until April 13, 2011. At that time, a search in PAIR was performed to determine the patent term of U.S. Patent No. 6,126,944 in order to determine how long the CDC would continue to collect royalties on the licenses for this patent. I realized that the second maintenance fee was never paid, and that no action had been taken in response to the Notice at that time. On April 13, 2011 the CDC database (Inteuim) still indicated that U.S. Patent No. 6,126,944 was issued and in good standing. Our internal database had no notation that this patent had expired. On April 13, 2011 the boxes that were shipped from Needle & Rosenberg directly to CDC for storage were reviewed and the patent file for U.S. Patent No. 6,126,944 was located in those boxes. I did not find a letter from Needle & Rosenberg or a status table in the boxes.

7. All statements made herein and of my own knowledge are true and all statements made on information are believed to be true; and further, these statements were made with the knowledge that willful false statements and like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any such willful false statements made may jeopardize the validity of the application or any patent issuing thereon.

Date

Sept 16, 2011

V. Fikovsky  
Valentin Fikovsky